

REMARKS

Entry of the foregoing, re-examination and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.112, and in light of the remarks which follow, are respectfully requested.

Claim 1 has been amended to specify that a portion of the synthetic fibers passes through the non-woven glass fiber-containing layer and penetrates the side of said layer which faces away from the synthetic fiber-containing layer. Support for this language may be found on page 12, lines 21-23 and claim 18. Claims 2, 4, 20 and 25 have been amended to correct errors. Claim 18 has been amended to delete subject matter added to claim 1.

The list of pending claims given in box 4 of the Office Action Summary (PTO-326) is believed to be inaccurate. Claims 1-10 and 12-41 are currently pending in this application with claims 19-39 withdrawn from consideration. Applicants wish to retain claims 19-39 so they can be rejoined with the elected claims pursuant to Section 821.04, M.P.E.P.

Applicants acknowledge with appreciation receipt of the initialed PTO-1449 form attached to the Office Action.

Claims 10 and 16 (and apparently claims 40 and 41) stand rejected under 35 U.S.C. §112, second paragraph, for the reasons given in paragraph (6) of the Office Action. Reconsideration of this rejection is respectfully requested for at least the following reasons.

With respect to claim 10, applicants reiterate their position that those of ordinary skill would have no trouble in appreciating the scope of the claims based on the description

in the disclosure and the knowledge possessed by those skilled in the art. The initial burden is on the Examiner to explain why those of ordinary skill would not be aware of techniques which heat shrink fibers without consolidation. Terminology identical to that set forth in claim 10 appears in the claims of U.S. Patent No. 6,235,657 and in the allowed claims of Serial No. 09/619,529. Thus, the Patent and Trademark Office in two related applications has examined and approved the same terminology.

Regarding claim 16, the Examiner is again referred to the disclosure on page 10, lines 8-20 for a description of what constitutes reinforcement as that term is used in the claim. Those of ordinary skill in this art would readily comprehend the scope of claim 16. The Examiner is also referred to claim 17 of U.S. Patent No. 6,412,154 and the supporting disclosure in column 3, lines 38-50 thereof which is identical to that on page 10, lines 1-18.

Based on the above, the §112 rejection of claims 10 and 16 should be withdrawn. Such action is earnestly requested.

Claim 18 was rejected under 35 U.S.C. §112, second paragraph, for reasons expressed in paragraph (7) of the Office Action. Reconsideration of this rejection is requested for at least the following reasons.

This rejection appears to be directed toward the last line of the claim. The features described in the last 5 lines of claim 18 are now specified in claim 1. Accordingly, claim 18 has been amended to delete this feature to avoid redundancy. In view thereof, this rejection should be withdrawn.

Claim 10 has been rejected under 35 U.S.C. §112, first paragraph, for reasons given in paragraph (9) of the Office Action. Reconsideration of this rejection is requested for at least the reasons which follow.

The position stated in the Office Action is that the specification "fails to teach a shrinking method that does not result in consolidation." Respectfully, this statement is incorrect. According to the specification, consolidation of the layer of synthetic fibers can take place before, after or simultaneously with heat shrinking and can be effected by calendering at temperatures lower than that employed for heat-shrinking. Those of ordinary skill in this art are aware of techniques to accomplish shrinking without consolidation.

Accordingly, this rejection should be reconsidered and withdrawn. Such action is earnestly solicited.

Claims 1, 4-6, 9, 14 and 15 have been rejected under 35 U.S.C. §102(b) as anticipated by newly cited U.S. Patent No. 5,616,395 to *Baravian et al* for the reasons expressed in paragraph (11) of the Office Action. Reconsideration of this rejection is requested for at least the following reasons.

The articles of *Baravian et al* '395 consist of two layers only. While needling is mentioned as a possible means of bonding the two layers, adhesive bonding is preferred as shown in Examples 1 and 2. No conditions for needle bonding are mentioned. Also, no consolidation of the glass fiber layer is contemplated since the document expressly states that consolidation and thermostabilization take place only in the first layer (synthetic fibers) and before assembly with the second layer (glass fibers); see column 6, lines 46-48.

The Office Action states that since *Baravian et al '395* discloses that the layers may be bound by needling, this "would inherently pass a portion of fibers from the first layer to the second layer" (page 5, line 8). However, the document fails to disclose any needling embodiments so it is mere conjecture to assume that the synthetic fiber layer is the upper layer such that needling would pass a portion of the synthetic fibers into the glass fiber layer. It is just as likely that the glass fiber layer would be the upper layer such that a portion of the glass fibers pass into the synthetic fiber layer.

It is well established that "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." *In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999)." "In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. of Pat. Apps. & Inter. 1990)." Note M.P.E.P. §2112. Based on these principles, Applicants respectfully submit that there is no basis in fact and/or technical

reasoning to reasonably support a conclusion that the allegedly inherent characteristic necessarily flows from the disclosure of *Baravian et al* '395.

The claims now specify that a portion of the synthetic fibers passes through the layer of glass fibers and penetrates through the side of said layer. The advantage of this feature is to securely anchor the synthetic fibers which have penetrated beyond the side of the glass fiber layer to the surface of the layer. This provides secure bonding of the layers which contributes to the overall mechanical strength and resistance to "banana curving" of the laminate.

As indicated above, a reference must disclose each and every feature recited in a claim to be anticipatory under 35 U.S.C. §102. *Baravian et al* '395 does not disclose laminates containing a pre-consolidated non-woven mat having glass staple fibers nor a needled laminate wherein a portion of the synthetic fibers pass through the non-woven layer of glass fibers and penetrate a side of the layer facing away from the layer of synthetic fibers. Accordingly, the §102(b) rejection should be withdrawn.

Claim 18 stands rejected under 35 U.S.C. §103(a) as "being anticipated by" *Baravian et al*. The Examiner's reasons are presented in paragraph (13) of the Office Action. Reconsideration is requested of this rejection for at least the following reasons.

Anticipation rejections are made under 35 U.S.C. §102; obviousness rejections are made under §103. Since the Examiner's reasons are couched in terms of inherency, Applicants assume a rejection under §102 was intended.

Applicants commented above that *Baravian et al* '395 does not mention the details of a needling operation so it is just as likely from the disclosure that needling could have

been accomplished when the glass fiber layer was the upper layer. In this case, a portion of the synthetic fibers would not pass through the glass fiber layer. The statement in the Office Action that needling would inherently result in penetration of the side of the glass fiber layer is mere conjecture. As those of ordinary skill are aware, there are many needling operations which deliberately avoid needling through the surface of the lower layer. Thus, penetration through the side of the glass fiber layer would not inherently occur in all needling procedures.

For the above reasons, the rejection of claim 18 is submitted to be unsound and should be withdrawn. Such action is respectfully requested.

Claims 2, 12 and 13 have been rejected under 35 U.S.C. §103(a) as unpatentable over *Baravian et al* '395 further in view of U.S. Patent No. 5,171,629 to *Heidel et al* for the reasons expressed in paragraph (14) of the Office Action. Reconsideration of this rejection is respectfully requested for at least the following reasons.

Heidel et al '629 is relied upon because it allegedly provides motivation for pre-consolidation of glass fiber mats with resinous binders. Applicants have previously noted that *Baravian et al* '395 does not contemplate consolidating the glass fiber layer. Only the synthetic fiber layer is to be consolidated as expressly disclosed in the primary reference. Thus, there is no motivation to combine *Baravian et al* '395 and *Heidel et al* '629 nor would there be a reasonable expectation of success that pre-consolidating the glass fiber layer of the primary reference would produce a laminate having the characteristics desired by *Baravian et al* '395.

Based on the above, the §103(a) rejection over *Baravian et al* '395 in view of *Heidel et al* '629 should be withdrawn. Such action is earnestly requested.

Claims 3, 7, 8, 16, 40 and 41 have been rejected under 35 U.S.C. §103(a) as unpatentable over *Baravian et al* '395 further in view of U.S. Patent No. 6,235,657 to *Schops et al* for the reasons set forth in the paragraph bridging pages 6-7 of the Office Action. Reconsideration of this rejection is requested for at least the following reasons.

The laminates described in *Schops et al* '657 comprise three layers as opposed to the two-layered laminates of *Baravian et al* '395. According to the latter, three-layered laminates are unsatisfactory for their purpose because the fire-screen (i.e., glass fiber layer) is between the synthetic fiber layers whereas it should be a surface layer (column 2, lines 9-15 of *Baravian et al* '395). Those of ordinary skill in this art would not seek to modify the invention of *Baravian et al* '395 as suggested in the Office Action because to do so would render patentees' invention inoperative for this purpose. As stated in Section 2143.02, M.P.E.P.: "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification" (page 2100-127, Rev. 1, Feb. 2003).

Also, *Schops et al* '657 does not disclose needling such that a portion of the synthetic fibers pass through the glass fiber layer and penetrate the surface thereof.

For at least the reasons set forth above, the §103(a) rejection based on *Baravian et al* '395 in view of *Schops et al* '657 should be withdrawn.

Claim 17 stands rejected under 35 U.S.C. §103(a) as unpatentable over *Baravian et al* '395 further in view of U.S. Patent No. 4,892,780 to Cochran et al for reasons given

in the paragraph bridging pages 7-8 of the Office Action. Reconsideration of this rejection is requested for at least the following reasons.

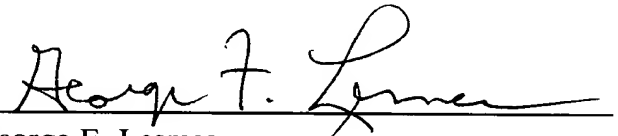
The Examiner refers to Example 15 of *Cochran et al '780*. Applicants have pointed out in previous Responses that Example 15 of *Cochran et al '780* relates to the use of E-glass in preparing knitted glass layers. There is no disclosure therein of non-woven layers containing fibers from E-glass. *Cochran et al '780* contains no disclosure or suggestion which would motivate those of ordinary skill to use E-glass in the non-woven layer of *Baravian et al '395*.

For at least the above reasons, the §103(a) rejection of claim 17 should be reconsidered and withdrawn.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at (703) 838-6683 at her earliest convenience.

Respectfully submitted,

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